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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,571	12/03/2001	Ian Tomlinson	8039/1125	6655
29933	7590	01/10/2005	EXAMINER	
PALMER & DODGE, LLP KATHLEEN M. WILLIAMS 111 HUNTINGTON AVENUE BOSTON, MA 02199			TRAN, MY CHAU T	
		ART UNIT		PAPER NUMBER
				1639

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/008,571	TOMLINSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MY-CHAU T TRAN	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 October 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-53 is/are pending in the application.  
4a) Of the above claim(s) 1-10,12-16,18-45,47,49 and 51-53 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) \_\_\_\_\_ is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) 11, 17, 46, 48, and 50 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of Claims***

1. Applicant's amendment filed 10/06/2004 is acknowledged and entered.
2. Claims 1-53 are pending.

***Election/Restrictions***

3. Applicant's election of Group III (Claims 11, 17, 46, 48, and 50) in the reply filed on 10/06/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 1-10, 12-16, 18-45, 47, 49, and 51-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to ***nonelected inventions***, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/06/2004.
5. However upon reconsideration of the elected Group III (Claims 11, 17, 46, 48, and 50), a further restriction requirement is required for Group III and the examiner apologizes for any inconvenience.
6. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 11 and 17, drawn to a method for creating a combinatorial library of two-chain polypeptides, classified in class 435, subclass 7.1.
- B. Claims 46, 48, and 50, drawn to a method for creating a combinatorial library comprising members of a first repertoire of polypeptides paired with members of a second repertoire of polypeptides, classified in class 435, subclass 7.2.

The inventions are distinct, each from the other because of the following reasons:

7. Inventions of Group A and Group B are drawn to two distinct methods, which differ in their method steps. The different method steps have different functions, modes of operation and different effects. Group A requires the method step of providing an array of members of the first repertoire juxtaposed with the members of the second repertoire which permits interaction of the first repertoire members and the second repertoire members. Group B requires the method step of transforming the cells as claimed in claim 46, or the step of infecting the cells as claimed in claim 48, or the step of mating the cells as claimed in claim 50. Thus these different inventions as claimed have different method steps that have different functions and modes of operation (MPEP § 806.04, MPEP § 808.01).

8. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group A would involve a determination of the patentability of the method for creating a combinatorial library of two-chain

polypeptides with the step of providing an array of members of the first repertoire juxtaposed with the members of the second repertoire which permits interaction of the first repertoire members and the second repertoire members while a patentability determination for Group B would involve a consideration of the patentability of the method for creating a combinatorial library comprising members of a first repertoire of polypeptides paired with members of a second repertoire of polypeptides with the step of transforming the cells. These considerations are very different in nature.

Even though some of the groups are classified in the same class and/or subclass, this has no effect on the non-patent literature search. Different groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
January 8, 2005



PADMASHRI PONNALURI  
PRIMARY EXAMINER